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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,607	01/14/2002	Andrew C. Gilbert	01-1034 CF/34	5741

7590 07/09/2007  
ESPEED INC  
110 EAST 59TH ST  
NEW YORK, NY 10022

EXAMINER
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TINKLER, MURIEL S

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/047,607	Applicant(s) GILBERT ET AL.	
	Examiner Muriel Tinkler	Art Unit 3691	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 13 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date <u>7/2/2003 4/29/2003</u><br/><u>613012603</u></p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|--|

### **DETAILED ACTION**

This application has been reviewed. Claims 1-16 are pending. There have been no amendments to the claims.

### ***Response to Arguments***

1. Applicant's arguments, see pages 1-2, filed March 28, 2007, with respect to the rejection(s) of claim(s) 1-16 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Silverman et al. (US 6,625,583 B1) and Silverman et al. (US 5,136,501 A).
2. The Examiner has not been persuaded that Ginsberg was in fact owned by eSpeed, Inc. at the time the Ginsberg et al. (US 2002/0019799 A1) invention was filed, hereafter referred to as Ginsberg. If in fact the Applicant is correct in that the same company owned Ginsberg at the time this invention was made, a Double Patenting rejection is applicable. As noted in the Double Patenting rejection section of the MPEP:
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.**

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The Examiner will give the Applicant the benefit of the double and assume the Applicant is accurate in that the Ginsberg invention was owned by eSpeed at the time this invention was filed. Because the Applicant has not proven this, and to expedite the examination process, a new Office Action has been performed by the Examiner using a reference (other than) Ginsberg.

***Claim Objections***

4. Claims 13 and 15 are objected to because of the following informalities: Claim 13 reads "a system of Claim 12" in line 1. Claim 13 should read "The system of Claim 12" instead. This minor error may lead to confusion in determining whether the term "a system of Claim 12" refers to the system already mentioned in Claim 12 or a new system. Also, Claim 15 reads "a system of Claim 14" in line 1. Claim 15 should read "The system of Claim 14" instead. This minor error may lead to confusion in determining whether the term "a system of Claim 14" refers to the system already mentioned in Claim 14 or a new system. Appropriate correction is required.

- a. Note: An appropriate resolution would be to change the term "A system of Claim" in line 1 of Claims 13 and 15 to read "The system of Claim".

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 1, 2, 6, 9, 10 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al. (US 6,625,583 B1) hereafter referred to as Silverman '583.

5. Claims 1 and 9 discuss a system and method for presenting a trading interface, comprising: receiving a first passive trading command from a broker workstation; receiving a second passive trading command from a principal workstation; displaying the first passive trading command and the second passive trading command using a special designation, which indicates bid availability on a trader workstation. Silverman '583 discloses the information in Claims 1 and 9. Specifically Silverman '583 discloses: the use of a broker in column 1 (lines 20-26); the use of a principle workstation or trading booth in column 1 (lines 27-40); sending and receiving passive trading commands in figure 1; displaying passive trading commands using use tabs in column 4 (lines 11-42).

7. Claims 2 and 10 discuss the system and method of claims 1 and 9, wherein the displaying of the first trading command and the second trading command comprises displaying the first passive trading command in a different manner from the second passive trading command wherein the different manner is using different colors, using different fonts, using flashing or hiding an unavailable passive trading command. Silverman '583 discloses the information in Claims 1, 2, 9 and 10. See the rejection(s) of Claims 1 and 9 above. Specifically Silverman '583 discloses displaying the first and

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second passive commands in a different manner in the Summary of the Invention in column 2 (lines 25-53).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3-5, 7, 8, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman '583 and Silverman et al. (US 5,136,501 A) hereafter referred to as Silverman '501.

9. Claims 3-5, 8, 11-13 and 16 discuss a system and method for trading, comprising: trader; receiving a trading command from a first determining whether the first trader is acting as a broker; trader; and presenting the trading command to a second preventing the second trader from acting on the trading command when the first trader is acting as

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a broker so that the trading command does not form part of the trade and blocking the completion of the transaction. Silverman '583 discloses the information in Claims 3-5, 8, 11-13 and 16. See the rejection(s) of Claims 1 and 9 above. Silverman '583 does not disclose the act of preventing a trader from acting on a trade. Silverman '501 teaches the art of preventing a trader from acting on a trade in the Abstract, column 3 (lines 18-38), column 4 (line 27) through column 5 (line 35) and column 17 (line 59) through column 18 (line 9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Silverman '583 to gain the ability to block trade because, according to Silverman '501 in Disclosure of the Invention, to controllably mask the available trading market and efficiently transmit only the required matching information to those key stations which require it.

10. Claims 6 and 14 discuss a system and method for trading, comprising: receiving a passive trading command from a first trader; receiving an aggressive trading command from a second trader; and enabling the second trader to execute a trade based upon a predetermined acceptance status set by either the first trader or the second trader.

Silverman '583 discloses the information in Claims 6 and 14. See the rejection(s) of Claims 1 and 9 above. Silverman '583 also discloses that act of enabling a trader to execute a trade based on predetermined acceptance status in figure 7 (element 711).

11. Claims 7 and 15 discuss the system and method of claims 6 and 14, further comprising: determining whether the first trader is acting as a broker; and preventing the



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second trader from acting on the aggressive trading command when the first trader is acting as a broker. Silverman '583 discloses the information in Claims 6, 7, 14 and 15. See the rejection(s) of Claim 6 and 14 above. See also the rejection of Claims 1 and 4 above.

### ***Conclusion***

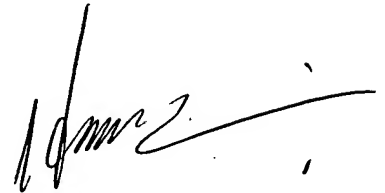
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT  
June 21, 2007

A handwritten signature in black ink, appearing to read 'Hani M. Kazimi', with a long horizontal stroke extending to the right.

HANI M. KAZIMI  
PRIMARY EXAMINER